

REMARKS

I. Status of the Claims

Claims 30-53 are pending. Claims 47-53 have been withdrawn by the Examiner as being allegedly drawn to a non-elected invention. As such, only claims 30-46 have been examined. No claim is amended.

II. Information Disclosure Statement

With the final Office Action, Applicants have received the Examiner-initialed PTO form 1449 filed June 18, 2003. Applicants thank the Examiner for considering the documents submitted with the Information Disclosure Statement filed June 18, 2003.

III. Rejection Under 35 U.S.C. § 103(a)

The Examiner has maintained the rejection of claims 30-46 under 35 U.S.C. §103(a) over Tomura et al. (U.S. Pat. No. 6,027,719) ("Tomura") in view of Lim et al. (U.S. Pat. No. 6,045,590) ("Lim") for the reasons of record. Office Action, p. 2. Applicants continue to disagree with the rejection because, at least, there is no evidence of a reasonable expectation of success and, further, there is no motivation to combine the references even if there was a reasonable expectation of success.

No Evidence of Reasonable Expectation of Success

In evaluating obviousness an Examiner must provide evidence of a "reasonable likelihood of success, viewed in the light of the prior art" at the time the invention was

made. *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); See M.P.E.P. § 2143.01.

Applicants respectfully submit that the Examiner has not directly addressed Applicants' arguments concerning reasonable expectation of success. Specifically, Applicants submit that there is no reasonable expectation of success in combining the teachings of Tomura with Lim, *inter alia*, because Tomura uses a hair dye composition that requires stable solubilization of uric acid whereas Lim does not.

Tomura repeatedly cautions that adding additional components would destabilize the solubilization of uric acid up to 2%, the primary objective of the invention. Tomura states in the "Background of the Invention" that "there are many problems [in producing a uric acid at a water solubility higher than 0.0067%] such as precipitation", and that "no satisfactory technique for stably solubilizing uric acid has yet been found." Col. 1, ll. 42, and 51-53. These statements by Tomura demonstrate the difficulty at the time of producing a stable solubilized uric acid system at a level above 0.0067% solubility. Also, Tomura warns that other ingredients "can be appropriately added in so far as they do not adversely affect the [solubility of uric acid]". Col. 3, ll. 50-52. Next, Tomura describes that only after they had "intensively studied the behavior of uric acid in aqueous cosmetic composition[s]" did they find that uric acid could be solubilized up to 2%. Col. 2, ll. 1-7. In sum, Tomura unambiguously states that uric acid solubilization above 0.0067% is crucially sensitive to solution conditions. To conform to Tomura's invention, any added ingredient must not disturb this solubilization. Thus, according to

Tomura, addition of other ingredients, generally, would unpredictably affect uric acid solubilization.

It follows, therefore, that one of ordinary skill in the art would not have reasonably expected success in combining Tomura with Lim, at least because (a) Tomura teaches that some surfactants are not satisfactory in solubilizing uric acid (Col. 1, ll. 50-53), and (b) no evidence has been provided that uric acid can be stably solubilized in the presence of acylsarcosinates or acylisethionates, the anionic surfactants of Lim to which the Examiner points. Thus, overall, Applicants respectfully submit that no evidence has been provided that one can combine Tomura's uric acid system and Lim's acylsarcosinates or acylisethionates and still maintain Tomura's stably soluble uric acid, especially when additives generally are expected to cause adverse effects on uric acid solubilization, according to Tomura's own statements.

Next, the Examiner infers that there is a reasonable expectation of success because "any of the species of the genus would have similar properties and thus, the same use as the genus as a whole." Office Action, p. 3. Applicants respectfully contend that this is incorrect. With regard to the genus of surfactants, all classes of surfactants do not have the same properties. For example, nonionic surfactants have different dissolution and stabilization properties compared to anionic surfactants. Indeed, Tomura indicates that not all surfactants are able to stably solubilize uric acid. Col. 1, ll. 50-53. With regard to the genus of anionic surfactants, it is also well-accepted that all anionic surfactants do not have the same properties. For example, the solubility and stabilization properties of phosphate-headed anionic surfactants can be significantly

different from those that are carboxylate-headed. Thus, Applicants submit that the Examiner's statement is not true when considering either the genus of surfactants or the genus of anionic surfactants. Therefore, Applicants respectfully submit that the Examiner's rationale is insufficient to provide a reasonable expectation of success, especially in the face of Tomura's statements regarding the unpredictable effects of surfactants on stably solubilizing uric acid.

Finally, Applicants respectfully contend that the Examiner's statement that surfactants or combinations of surfactants can be added "for viscosity purposes" (Office Action, page 3) does not cure the lack of a reasonable expectation of success because it does not address the issue of the unpredictability of uric acid solubilization.

No Motivation to Combine

In order to establish a *prima facie* case of obviousness, an Examiner must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. The Federal Circuit has emphasized the Examiner's high burden for establishing a *prima facie* case of obviousness and the requirement for specificity in the evidence necessary to support a *prima facie* case. For example, in *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277 F.3d 1338, 1433 (Fed. Cir.

2002) (emphasis added). *See also In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999) (requiring a “clear and particular” suggestion to combine prior art references).

In the “Response to Applicant’s Arguments”, the Examiner infers that there is a motivation to include our claimed surfactants in Tomura’s composition because:

(a) “Tomura discloses the use of anionic surfactants as the genus in a hair dy[e]ing composition,”

(b) “Tomura suggests ... it is necessary to add surfactants and polymers in view of usability,” and

(c) Lim suggests that different species of or combinations of anionic surfactants “can be used to impart particular viscosity and foaming properties.”

Office Action, p. 2.

Regarding point (a), the Examiner cites Tomura at column 3, lines 42-44, but fails to address the statement at the end of that same paragraph which states that anionic surfactants “can [only be] added in so far as they **do not adversely affect the present invention.**” Col. 3, ll. 50-52 (emphasis added). This phrase conditions the addition of anionic surfactants on their not adversely affecting the uric acid stabilization. As such, Applicants respectfully submit that this phrase reduces the alleged motivational statement to that of an obvious-to-try statement for the anionic surfactant; but, as the Examiner knows, the obvious-to-try standard is not sufficient to make a *prima facie* case of obviousness. *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988) (choosing among a varying range of possibilities presented in the prior art, where the prior art had no

indication or direction of a successful result within that range, is not obvious);

M.P.E.P. 2145 X.B.

On point (b), the Examiner cites column 1, lines 49-50, but the Examiner does not address the statement following the quoted passage: "However, in aqueous cosmetic compositions containing surfactants and polymers, no satisfactory technique for stably solubilizing uric acid has yet been found." Col. 1, ll. 51-54. Applicants respectfully submit that this statement negates the inference by the Examiner that any Lim surfactant could be used in the Tomura invention. Uric acid solubility as discussed in Tomura is very sensitive and central to the Tomura invention; yet uric acid solubilization is never mentioned in Lim because Lim's invention is not concerned with it. Thus, how is it possible that Lim could have motivated the addition of acylsarcosinates or acylisethionates while maintaining uric acid solubilization and enzyme activity when Lim does not address these considerations at all? At best it would be obvious to try, but, as discussed above, an obvious-to-try standard is not sufficient to establish a *prima facie* case of obviousness.

Thus, with regard to points (a) and (b), Applicants respectfully contend that the Examiner has improperly selected statements from Tomura without considering the reference as a whole. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." M.P.E.P. § 2141.02 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). By ignoring the very purpose of Tomura's invention and especially the statements following the passages

quoted by the Examiner, Applicants respectfully submit that the Examiner has not to considered Tomura as a whole. This is particularly important here because when Tomura is considered as a whole, it does not yield the predictability required to establish a reasonable expectation of success, as discussed above.

With respect to point (c), the fact that a single anionic surfactant species or a combination of surfactants can be used to "impart viscosity and foaming properties" is insufficient to provide motivation to combine Lim with Tomura. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests that desirability of the combination." M.P.E.P. § 2143.01 citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Here, the Examiner has provided no motivation for why one of ordinary skill in the art at the time the invention was made would have chosen to use the anionic surfactants from Lim in the sensitive, delicately balanced uric-acid containing hair dye system of Tomura. Thus, Applicants respectfully submit that there is no suggestion of the desirability of this combination in either Lim or Tomura.

For at least these reasons, Applicants request the withdrawal of this rejection.

IV. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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